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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/029,579	05/06/1998	ULF LANDEGREN	1209-122P	6255

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FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP
FOUR EMBARCADERO CENTER
SUITE 3400
SAN FRANCISCO, CA 94111-4187

EXAMINER	
AKHAVAN, RAMIN	

ART UNIT	PAPER NUMBER
1636	

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/029,579	LANDEGREN, ULF	
	Examiner	Art Unit	
	Ramin (Ray) Akhavan	1636	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on *03 December 2003*. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *7 and 9-12*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☒ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). *12/03/2003*.

10. ☐ Other: _____

JAMES KETTER
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because:

The proposed amendment introduce new issues that would require further consideration and/or search. With the proposed amendment, claim 7 would inhere the additional limitation, "wherein the composition does not contain said target nucleic acid". This limitation was not previously searched or considered.

Because the amendments are not being entered, only arguments not relying on the proposed amendments will be addressed. However, the arguments could equally be applied, even if the porposed amendments were entered. The arguments made are not deemed persuasive. Applicant indicates that the Nilsson reference only teaches padlock probes that bind single stranded nucleic acids, thus distinguishing applicant's composition, which targets double stranded nucleic acids. Nilsson teaches the same composition that applicant claims and whether the composition is intrinsically able to bind single or double stranded nucleic acids is not determinative of patentability.

In addition applicant contends that it was not known in the art that Nilsson's ligation buffer was inherently a pharmaceutically acceptable carrier. Furthermore, applicant indicates that use of separate references to teach each component of the ligation buffer as pharmaceutically acceptable supports the preceding contention. Whether it was known that the ligation buffer in Nilsson is pharmaceutically acceptable or not, would not by itself change the intrinsic characteristics of the ligation buffer. The separate references are merely provided as extrinsic evidence that the ligation buffer is comprised of pharmaceutically acceptable components. Therefore, even if the additional references were omitted, the basis for the rejection would remain viable and the same.